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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) TRMB-1412	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>April 23, 2007</u> Signature <u>Mary Elias</u> Typed or printed name <u>Mary Elias</u>		Application Number 10/651,586	Filed 08/29/2003
		First Named Inventor Dennis York	
		Art Unit 2182	Examiner Peyton, Tammara R.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)
- ☒ attorney or agent of record.
Registration number 35,398
- ☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Signature
John P. Wagner, Jr.

Typed or printed name
408-234-3649

Telephone number
04/23/2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

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Remarks Accompanying Pre-Appeal Brief Request For Review

In response to the final Office Action dated January 24, 2007, Applicants respectfully request a review of the final rejection in the above-identified application. Applicants respectfully submit that the Examiner's rejections of the Claims 1-19 under 35 USC 103(a) as being unpatentable over Dickie (6,798,647) is improper as an essential element needed for a proper prima facie rejections is missing (e.g., the teaching of all of the recited claim limitations).

Rejection under 35 U.S.C. §103 (a)

KEY CLAIM LIMITATIONS THAT ARE NOT MET BY THE CITED REFERENCES

Claims 1 and 15 set forth a processing unit for an electronic instrument comprising:

- a signal/data processor;
- an exposed external electrical contact for receiving electric power input;
- an exposed external electrical contact for receiving an electric signal input;
- an exposed external electrical contact for transmitting an electrical signal output;

and

- a housing comprising mechanical retention features for securely attaching a battery/input/output module.

In the final Office Action, the Examiner has referenced Figure 4 of Dickie as containing subject matter that teaches the aforementioned features of Claims 1 and 15. The Appellant respectfully disagrees with the Examiner. That is, the Appellant does not understand Dickie to teach or render obvious the features of Claims 1 and 15.

In the Office Action, the Examiner states "a housing (102) comprising mechanical retention features for securely attaching a battery/input/output module. (see figure 4, housing of PDA 102 securely attaches to battery/input/output module 104, col. 3, lines 62-col. 4, lines 1-47)."

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). (MPEP 2143.03).

Appellant does not understand the components 102 and 104 of Dickie to teach or render obvious the features of Claims 1 and 15. Specifically, Appellant understands Dickie to teach that the PDA 102 can be docked into the docking cradle 120. The portable computer 104 physically stores and protects the PDA 102 when docked so that the user can easily carry both the portable computer 104 and PDA 102 (emphasis added).

Thus, Appellant respectfully submits that 104 is not a battery/input/output module as stated by the Examiner but is instead a portable computer 104. Moreover, Claims 1 and 15 clearly state “a housing comprising mechanical retention features for securely attaching a battery/input/output module” (emphasis added). Thus, it is the housing that retains the battery/input/output module in Claims 1 and 15.

In contrast, Appellant respectfully states that Dickie teaches that it is the portable computer 104 that physically stores and protects the PDA 102 when docked (emphasis added). For this reason, Appellant respectfully states that Dickie does not teach or render obvious the features of Claims 1 and 15. As such, the rejection under 35 U.S.C. §103(a) is improper as an essential element needed for a proper prima facie rejection is missing.

In addition, Appellant does not understand the components 102 and 104 of Dickie to teach or render obvious the features of Claims 1 and 15. Specifically, Appellant further understands Dickie to teach (at column 3 lines 10-21), the integrated PDA docking cradle 120 offers the cradle functionality to interface the PDA 102 with the portable computer 104, thereby eliminating the need for external docking cradles. When docked, the PDA 102 is able to communicate with the portable computer 104, via either direct electrical coupling or other means (e.g., proximity coupling, JR coupling, RF coupling, etc.). The PDA 102 and portable computer 104 can exchange data to

synchronize various information, such as appointments, email, contacts, and so on. Additionally, power may be supplied to charge a battery resident at the PDA 102 (emphasis added).

Thus, Appellant respectfully submits that PDA 102 of Dickie is already taught as having its own battery and that the portable computer 104 of Dickie is not a battery/input/output module as stated by the Examiner but is instead a dock as taught by Dickie.

For this additional reason, Appellant respectfully states that Dickie does not teach or render obvious the features of Claims 1 and 15. As such, the rejection under 35 U.S.C. §103(a) is improper as an essential element needed for a proper prima facie rejections is missing.

Additional arguments provided on pages 6-10 of the response to the Non-Final Office Action dated October 26, 2006 are also referenced.

Regarding Claims 1-7 and 16-20, Appellant respectfully submits that Claims 1-7 and 16-20 are also allowable as pending from allowable base Claims and reciting further features of the Claimed invention.

With respect to Independent Claim 8, Applicant respectfully states that Claim 8 includes the features “A portable battery/input/output module for a portable electronic instrument comprising:

- a storage device for electric energy;
- an exposed external electrical contact for transmitting electric power;
- an exposed external electrical contact for receiving an electric signal input;
- an exposed external electrical contact for transmitting an electrical signal output;
- a housing comprising mechanical retention features for securely attaching a processing unit.”

As previously stated herein, Appellant understands the Examiner to state that Dickie teaches the claimed feature of a battery/input/output module with element 104, a portable computer 104 (e.g., laptop, notebook, etc.). Applicant respectfully disagrees that a portable computer 104 (e.g., laptop, notebook, etc.) is the same as a battery/input/output module.

For at least the same reasons provided above, e.g., the portable computer 104 physically stores and protects the PDA 102 when docked and that PDA 102 of Dickie is already taught as having its own battery and that the portable computer 104 of Dickie is not a battery/input/output module as stated by the Examiner but is instead a dock as taught by Dickie (emphasis added). Appellant respectfully submits that Dickie does not teach or render obvious the features of “A portable battery/input/output module for a portable electronic instrument comprising: a storage device for electric energy; an exposed external electrical contact for transmitting electric power; an exposed external electrical contact for receiving an electric signal input; an exposed external electrical contact for transmitting an electrical signal output; a housing comprising mechanical retention features for securely attaching a processing unit as provided in Claim 8. As such, the rejection under 35 U.S.C. §103(a) is improper as an essential element needed for a proper prima facie rejection is missing.

Additional arguments provided on pages 6-8 of the response to the Non-Final Office Action dated June 29, 2005 are also referenced.

Regarding Claims 9-14, Appellant respectfully submits that Claims 9-14 are also allowable as pending from an allowable base Claim and reciting further features of the Claimed invention.

Regarding Claims 10-13, Appellant did not find any reasons cited by the Examiner for the rejection of Claims 10-13. For this reason, Appellant submits that the undisclosed rejection of Claims 10-13 is improper and that claims 10-13 are allowable.